

Attorney Docket No.: 5218-104  
Application Serial No.: 10/782,460  
Filed: February 19, 2004  
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### REMARKS

Claims 1-4 are pending in this application. Claim 1 is amended herein for clarity to more particularly define the invention. Claim 2 is canceled herein without prejudice. New claims 5-10 are added herein. Support for this amendment and new claims is found in the original claim language and throughout the specification, as set forth below. No new matter is introduced by this amendment and new claims and applicants respectfully request their entry and examination. In light of this amendment and new claims and the following remarks, applicants respectfully request reconsideration of this application and allowance of the pending claims to issue.

#### I. Rejection under 35 U.S.C. § 112, first paragraph

The Office Action states that claims 1-4 are rejected under 35 U.S.C. § 112, first paragraph, on the basis that the claims are enabled for a composition which contains all of the components as claimed but that the claims are allegedly not enabled for less than all of the components or for a composition containing all of the components which is not produced from intestinal and testicular tissue of the male blue crab.

Claim 1 is amended herein to incorporate the language of claim 2 in order to expedite prosecution of this application to issue, although applicants do not concede that the application is not enabled for compositions comprising the components that are produced from sources other than the intestinal and testicular tissue of the male blue crab and applicants reserve the right to pursue claims to such compositions in continuation applications. Furthermore, the application is adequately enabled for the composition of claim 1 on the basis that it would be routine for any person of skill in the art to produce the composition of claim 1 and add or subtract any of the components of claim 1 according to methods set forth in the specification and according to well known methods in the chemical arts for fractionating, separating, purifying and/or synthesizing chemical compositions (see, e.g., page 31, lines 18-19). Such methods are routine in the art and it is well known that art-known protocols need not be specifically disclosed in a patent specification. Thus, it would be apparent to one of ordinary skill in the art that all of the information needed for carrying out such methods to produce a composition of claim 1 is adequately recited in the

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application and the claims. The resulting compositions would then be tested by the ordinary artisan according to the methods set forth in the specification for identifying compositions with female crab-attractant activity (see e.g. pages 4 and 5, Section II of Example 1, entitled "Testing of composition.").

In choosing which components to select, the specification provides guidance on page 3, lines 14-15 and on page 5, lines 42-45, wherein it is stated that the composition of this invention contains components with pheromone activity and/or a high probability of functioning as a pheromone. The selection of components having pheromone activity and/or a high probability of functioning as a pheromone from the defined list of components of claim 1 would be routine to one of ordinary skill in the chemical arts. From this guidance, one of skill in the art could start with one or more of the components of claim 1 that have or are likely to have pheromone activity and add or subtract other components from this list and ultimately test the resulting compositions for female blue crab-attractant activity. All of these protocols and selections would be routine to the artisan and would not required experimentation that would be undue.

Thus it is apparent that it would not require undue experimentation of one of ordinary skill in the art to make and test various compositions of claim 1 and identify those that are operative. Furthermore, it is well established in patent case law that the presence of inoperative embodiments within the scope of a claim does not necessarily render a claim nonenabled. The standard is whether a skilled person could determine which embodiments that were conceived, but not yet made, would be inoperative or operative with expenditure of no more effort than is normally required in the art. *Atlas Powder Co. v. E.I. du Pont de Nemours & Co.*, 750 F.2d 1569, 1577, 224 USPQ 409, 414 (Fed. Cir. 1984) (prophetic examples do not make the disclosure nonenabling). (See MPEP § 2164.08(b)). As explained herein, it is clear that the teachings of the instant specification and art-known protocols provide adequate guidance for one of ordinary skill in the art to produce and test the compounds of the claimed invention and readily identify those that are operative or inoperative without undue experimentation.

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For all of the reasons set forth above, the invention as claimed is adequately enabled. Therefore, this rejection is believed to be overcome and applicants respectfully request its withdrawal.

## **II. Rejection under 35 U.S.C. § 102(b)**

The Office Action states that claim 1 is rejected under 35 U.S.C. § 102(b) as allegedly anticipated by Beck et al. Specifically, the Office Action states that Beck et al. expressly discloses a mixture of docasane or eicosane.

Claim 1 is amended herein to recite a composition produced from intestinal and testicular tissue of a male blue crab. This composition is not disclosed in Beck et al. and therefore, Beck et al. does not anticipate this claim. Thus, this rejection is believed to be overcome and applicants respectfully request its withdrawal.

## **III. New claims 5-10**

The following new claims are added herein. New claim 5 recites a composition comprising a homogenous emulsion of testicular material isolated from a male blue crab, wherein the composition has activity in attracting female blue crabs to a trap. New claim 6 recites the composition of claim 5, further comprising a homogenous emulsion of intestinal material isolated from a male blue crab. Support for these new claims is found throughout the specification and in the language of the original claims as provided, at least for example on page 3, lines 19-21 and lines 47-49 and in the Examples. New claims 7 and 8 recite a method of attracting female blue crabs to a trap, comprising introducing into said trap an amount of the composition of claim 5 or 6 effective in attracting female blue crabs into the trap. Support for new claims 7 and 8 is also found throughout the specification and in the language of the original claims, as provided, at least for example, on page 4, lines 1-13.

These new claims are adequately described and enabled in the present specification and the pending art rejection does not apply. Thus, these new claims are believed to be allowable, which

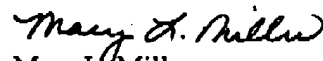
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action is respectfully requested.

For all the reasons set forth above, applicants believe that the pending rejections in this application have been overcome and their withdrawal is respectfully requested. The Examiner is invited and encouraged to contact the undersigned directly if such contact will expedite the prosecution of the pending claims to issue. In particular, should the Examiner make a determination that none of the claims presented herein are allowable, applicants respectfully request a telephone interview with the Examiner and the Examiner's supervisor PRIOR to the issuance of a final Office Action.

The Commissioner is authorized to charge Deposit Account No. 50-0220 in the amount of \$225.00 for a two month extension of time for a small entity. This amount is believed to be correct. However, the Commissioner is hereby authorized to charge any deficiency related to this matter or credit any overpayment to Deposit Account No. 50-0220.

Respectfully submitted,

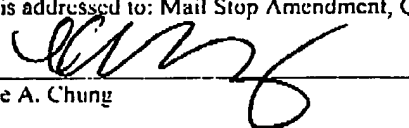
  
Mary L. Miller  
Registration No. 39,303

USPTO Customer No. 20792  
Myers Bigel Sibley & Sajovec, P.A.  
Post Office Box 37428  
Raleigh, North Carolina 27627  
Telephone: (919) 854-1400  
Facsimile: (919) 854-1401

**CERTIFICATE OF FACSIMILE TRANSMISSION**

Date of Deposit: September 6, 2005

I hereby certify that this correspondence is being facsimile transmitted to 571-273-8300 on the date indicated above and is addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

  
Katie A. Chung